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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,856	08/02/2001	Gregory P. Fitzpatrick	BOC9-2000-0082(217)	7129

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EXAMINER

ABEL JALIL, NEVEEN

ART UNIT	PAPER NUMBER
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2175

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/921,856

Applicant(s)

FITZPATRICK ET AL.

Examiner

Neveen Abel-Jalil

Art Unit

2175

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on January 28, 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The amendment filed on January 28, 2004 has been received and entered. Claims 1-17 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolnick et al. (U.S. Pub. No. 2002/0023230 A1) in view of Harari (U.S. Pub. No. 2002/0016857 A1).

As to claims 1, and 12, Bolnick et al. discloses a method for generating a list of contacts (See page 7, paragraphs 0115-0118), a machine readable storage having stored thereon a computer program for generating a list of contacts (See page 2, paragraph 0025), said machine readable storage having a plurality of code sections executable by a machine for causing the machine to perform a series of steps comprising the steps of:

first retrieving a plurality of contacts from an exposed, remotely accessible contact list (See pages 2-3, paragraphs 0026-0027) associated with a user (See page 9, paragraphs 0170-0171),

first comparing said first retrieved contacts to stored contacts in a locally accessible contact list (See page 8, paragraphs 0162-0167, wherein "comparator" reads on "out-of-date")

associated with a different user (See page 4, paragraphs 0065-0066, wherein “associated with a different user” reads on “to be shared”);

second retrieving a plurality of contacts from an exposed, remotely accessible contact list associated with one of said first retrieved contacts; second comparing said second retrieved contacts to said locally stored contacts (See page 8, paragraphs 0167-0171, also see abstract, and see page 5, paragraphs 0068-0070).

Bolnick et al. does not disclose first identifying common contacts among said first compared contacts; second identifying common contacts among said second compared contacts; and,

storing said identified common contacts in a list of common contacts.

Harari discloses first identifying common contacts among said first compared contacts; second identifying common contacts among said second compared contacts; and, storing said identified common contacts in a list of common contacts (See page 3, paragraphs 0031-0033, also see page 5, paragraphs 0043-0046).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Bolnick et al. to include first identifying common contacts among said first compared contacts; second identifying common contacts among said second compared contacts; and, storing said identified common contacts in a list of common contacts.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Bolnick et al. by the teaching of Harari to include first identifying common contacts among said first compared contacts; second identifying common contacts among said second compared contacts; and, storing said identified common contacts in a list of

Art Unit: 2175

common contacts because it provides for efficient database organization and access thereby reducing processing time and business expenses.

As to claims 2, and 13, Bolnick et al. as modified discloses further comprising the step of repeating said second retrieving, second comparing and second identifying steps for each first retrieved contact not identified as a common contact in said first identifying step (See page 4, paragraph 0065, wherein “not identified” reads on “determination of shared access”, also see page 4, paragraph 0067, also see pages 5-6, paragraphs 0086-0087).

As to claims 3, and 14, Bolnick et al. as modified discloses wherein said second retrieving step comprises the step of second retrieving a plurality of contacts from an exposed, remotely accessible contact list associated with one of said first retrieved contacts not identified as a common contact in said first identifying step (See page 6, paragraph 0108, wherein “not identified as common contact” reads on “can be integrated into member’s display list”).

As to claims 4, and 15, Bolnick et al. discloses a method generating a list of common contacts (See page 7, paragraphs 0115-0118), a machine readable storage having stored thereon a computer program for generating a list of common contacts, said machine readable storage having a plurality of code sections executable by a machine for causing the machine to perform a series of steps, said steps comprising:

Bolnick et al. does not disclose exchanging at least two contact lists over a physical communications link, wherein each contact list corresponds to a different user;

Art Unit: 2175

comparing contacts in said exchanged contact lists to identify matching contacts; and, storing said matched contacts in a common contact list.

Harari discloses exchanging at least two contact lists over a physical communications link, wherein each contact list corresponds to a different user (See page 1, paragraphs 0006-0017);

comparing contacts in said exchanged contact lists to identify matching contacts; and, storing said matched contacts in a common contact list (See page 3, paragraphs 0031-0033, also see page 5, paragraphs 0043-0046).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Bolnick et al. to include exchanging at least two contact lists over a physical communications link, wherein each contact list corresponds to a different user; comparing contacts in said exchanged contact lists to identify matching contacts; and, storing said matched contacts in a common contact list.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Bolnick et al. by the teaching of Harari to include exchanging at least two contact lists over a physical communications link, wherein each contact list corresponds to a different user; comparing contacts in said exchanged contact lists to identify matching contacts; and, storing said matched contacts in a common contact list because it provides for efficient database organization and access thereby reducing processing time and business expenses.

As to claims 5, and 16, Bolnick et al. discloses wherein said exchanging step comprises the steps of: establishing a wireless communications link; and, exchanging said contact lists over

said established wireless communications link (See page 8, paragraph 0167, wherein “exchanging” reads on “sharing”)

As to claims 6, and 17, Bolnick et al. discloses a method of generating a list of common contacts (See page 7, paragraphs 0115-0118), A machine readable storage having stored thereon a computer program for generating a list of common contacts, said machine readable storage having a plurality of code sections executable by a machine for causing the machine to perform a series of steps (See page 2, paragraph 0025), said steps comprising:

accessing a contact list in a remotely accessible database of contacts (See page 4, paragraphs 0063-0065, also see page 6, paragraph 0108);

providing a visual hyperlink for each matching contact produced by said comparing step (See page 1, paragraph 0013, also see page 8, paragraphs 0167-069).

Bolnick et al. does not disclose comparing contacts in said contact list with contacts in a stored database of contacts, said comparison producing matching contacts, wherein said contact list and said contacts in a stored database of contacts each corresponding to a different user.

Harari discloses comparing contacts in said contact list with contacts in a stored database of contacts, said comparison producing matching contacts (See page 3, paragraphs 0031-0033, also see page 5, paragraphs 0043-0046), wherein said contact list and said contacts in a stored database of contacts each corresponding to a different user (See page 1, paragraphs 0006-0017).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Bolnick et al. to include comparing contacts in said contact list with contacts in a stored database of contacts, said comparison producing matching contacts,

Art Unit: 2175

wherein said contact list and said contacts in a stored database of contacts each corresponding to a different user.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Bolnick et al. by the teaching of Harari to include comparing contacts in said contact list with contacts in a stored database of contacts, said comparison producing matching contacts, wherein said contact list and said contacts in a stored database of contacts each corresponding to a different user because it provides for efficient database organization and access thereby reducing processing time and business expenses.

As to claim 7, Bolnick et al. discloses a common contact identification system (See page 7, paragraphs 0115-0118) comprising:

at least two contact lists, each said contact list comprising a plurality of contacts, each said contact list having a publicly accessible interface through which said contacts can be accessed remotely (See page 2, paragraphs 0018, also see pages 2-3, paragraphs 0025-0027, wherein “publicly accessible” reads on “Internet”, also see page 4, paragraph 0065, wherein “contact lists” reads on “address book”, also see page 3, paragraphs 0034-0036, wherein “accessed remotely” reads on “Instant Messenger”);

a comparator for comparing contacts in each of said at least two contact lists, said comparator identifying matching contacts in each of said at least two contact lists (See figure 7, shows two PDA's indicating two contact lists, also see page 10, paragraphs 0238-0239, also see page 9, paragraph 0202, and see page 8, paragraphs 0167-0169).

Bolnick et al. does not disclose each said contact list corresponding to a different user;

a common contact list comprising contacts matched by said comparator.

Harari discloses each said contact list corresponding to a different user (See page 1, paragraphs 0006-0017);

a common contact list comprising contacts matched by said comparator (See page 3, paragraphs 0031-0033, also see page 5, paragraphs 0043-0046).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Bolnick et al. to include each said contact list corresponding to a different user; a common contact list comprising contacts matched by said comparator.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Bolnick et al. by the teaching of Harari to include each said contact list corresponding to a different user; a common contact list comprising contacts matched by said comparator because it provides for efficient database organization and access thereby reducing processing time and business expenses.

As to claim 8, Bolnick et al. as modified discloses wherein each said contact list is stored in a storage medium selected from the group consisting of a database (See page 3, paragraph 0032), a contact management program data store (See page 2, paragraph 0014), an e-mail program address book; an instant messenger address book, a cellular phone address book, and a personal digital assistant address book (See page 10, paragraphs 0227-0231, wherein "cellular phone" reads on "wireless").

a common contact list comprising contacts matched by said comparator.

Harari discloses each said contact list corresponding to a different user (See page 1, paragraphs 0006-0017);

a common contact list comprising contacts matched by said comparator (See page 3, paragraphs 0031-0033, also see page 5, paragraphs 0043-0046).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Bolnick et al. to include each said contact list corresponding to a different user; a common contact list comprising contacts matched by said comparator.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Bolnick et al. by the teaching of Harari to include each said contact list corresponding to a different user; a common contact list comprising contacts matched by said comparator because it provides for efficient database organization and access thereby reducing processing time and business expenses.

As to claim 8, Bolnick et al. as modified discloses wherein each said contact list is stored in a storage medium selected from the group consisting of a database (See page 3, paragraph 0032), a contact management program data store (See page 2, paragraph 0014), an e-mail program address book; an instant messenger address book, a cellular phone address book, and a personal digital assistant address book (See page 10, paragraphs 0227-0231, wherein "cellular phone" reads on "wireless").

As to claim 9, Bolnick et al. as modified discloses further comprising a communications link between said contact lists over which said contacts in said contact lists can be transmitted (See pages 2-3, paragraphs 0026-0027, wherein “communication link” reads on “Internet”).

As to claim 10, Bolnick et al. as modified discloses wherein said communications link is selected from the group consisting of an infrared communications link, a short range radio frequency communications link, and a TCP/IP wireline link (See Harari page 1, paragraph 0017).

As to claim 11, Bolnick et al. as modified discloses wherein said common contact list comprises at least one hyperlinked address of a matched contact (See page 1, paragraph 0013, also see page 8, paragraphs 0167-069).

Response to Arguments

4. Applicant's arguments filed on January 28, 2004 have been fully considered but they are not persuasive.

Applicant's argument that “Bolnick et al. fails to teach or suggest the step of first comparing the first retrieved contacts to stored contacts in a locally accessible contact list” is respectfully acknowledged but it is not deemed to be persuasive.

In the office action, the Examiner by referring to Bolnick et al. paragraphs 0167 teaching about “out-of-date” contacts, the Examiner is using her broadest reasonable interpretation of a comparison is taking place within the system to be able produce an “out-of-date” list of contacts. There's a synchronization between all linked users and their contact list meaning a comparison

Art Unit: 2175

and creation of an up-to-date list is taking place. See Bolnick et al. page 8, paragraphs 0162-0167, and see Bolnick et al. page 7, paragraph 0144, and page 12, claim 2 language showing a “synchronization device”. It is clear to the Examiner under the broadest interpretation that a comparator is being deployed “synchronization device in this case” to perform the functions of “shared” information described by Bolnick et al.’ invention. How else dose the system send a “list of out of date contacts”?

In response to the Applicant’s arguments on pages 8, 9, and 10 that “Bolnick et al. does not teach any sort of comparing step, i.e., that contacts from a remotely accessible contact list can be compared with stored contacts in a locally accessible contact list” is fully acknowledged but is not deemed to be persuasive.

The Examiner respectfully points to the rejection above wherein Bolnick et al. clearly teaches the contact list is locally stored on a client computer or a PDA and being able to be shared and synchronized with other user of the system either by direct link or an upload of the system on (See Bolnick et al. page 8, paragraphs 0162-0167, wherein “comparator” reads on “out-of-date”). Bolnick et al. teaches the contact list associated with a different user on page 4, paragraphs 0065-0066, wherein “associated with a different user” reads on “to be shared”. Throughout the invention, Bolnick et al. discusses the capability of the user to add associations and to promote contacts lists and shared calendars and the link with diverse groups of other users as shown on page 5, paragraphs 0077-0086, and on pages 8-9, paragraphs 0162-0184.

In response to Applicant's arguments on pages 8, and 9, that "Bolnick et al. does not teach or suggest the steps of second retrieving a plurality of contacts from an exposed, remotely accessible contact list associated with one of the first retrieved contacts and second comparing the second retrieved contacts to the locally stored contacts" is fully acknowledged but is not deemed to be persuasive.

The Examiner respectfully points to Bolnick et al. where "retrieving a plurality of contacts from an exposed, remotely accessible contact list" is clearly taught by providing a shared groupware based or an instant message service by many users via a web link (see Bolnick et al. abstract, also see Bolnick et al. page 8, paragraphs 0152-0169). The Examiner broadly interprets Bolnick et al.'s teachings of "out-of-date" contacts and a synchronization device to read on a comparator taking place as discussed in the response to arguments above. The rejection of the claims is under the combination of Bolnick et al. with the teachings of Harari which also teaches on page 5, paragraphs 0045-0046, and see figure 3 comparing the address book of networked remote users to each other.

In response to Applicant's argument that "Harari, like Bolnick et al., fails to teach or suggest that contact lists of different users can be compared to identify common contacts" is fully acknowledged but is not deemed to be persuasive.

The Examiner respectfully maintains that Harari was introduced as a secondary reference to teach first identifying common contacts among said first compared contacts; second identifying common contacts among said second compared contacts; and, storing said identified common contacts in a list of common contacts (See Harari page 3, paragraphs 0031-0033, also

see Harari page 5, paragraphs 0043-0046). Harari teaches most recent address contact list and allows the system to accept or discard the difference which is being broadly interpreted in combination with the teachings of Bolnick et al. to teach comparator and synchronizer (see response to argument above).

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 703-305-8114. The examiner can normally be reached on 8:00AM-4:30PM.

Art Unit: 2175

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on 703-305-3830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Neveen Abel-Jalil
April 4, 2004


CHARLES RONES
PRIMARY EXAMINER